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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,656	09/30/2003	Harlan Silverstein	HS072402USNP	4782
7590 09/03/2004				
Markets, Patents & Alliances LLC		EXAMINER		
30 Glen Terrace		WILLIAMS, MARK A		
Stamford, CT 06906-1401				
		ART UNIT	PAPER NUMBER	
		3676		
DATE MAILED: 09/03/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,656

Applicant(s)

SILVERSTEIN ET AL.

Examiner

Mark A. Williams

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-18 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☒ Claim(s) 13, 19-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35

U.S.C. 121:

- I. Claims 1-12 and 14-18, drawn to a caster, classified in class 16, subclass 35R.
- II. Claim 13, drawn to a control system, classified in class 137, subclass 596.18.
- III. Claims 19 and 20, drawn to method of moving and locking an object, classified in class 280, subclass 264.
- IV. Claims 21, 22, and 23, drawn to a theatrical production, classified in class 705, subclass 1.
- V. Claims 24 and 25, drawn to a dual wheel pneumatic locking caster, classified in class 16, subclass 18R.

The inventions are distinct, each from the other because of the following reasons:

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2. Inventions I-V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as being used in a whole host of applications (for example, in an industrial cart or trolley), other than a theatrical production, by the particular method, in a dual wheel caster, or with the particular claimed control system. See MPEP § 806.05(d).

3. During a telephone conversation with Mark Nowatarski on 8/26/04 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-12 and 14-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13 and 19-25 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment

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of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

5. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “or the like” renders the claim indefinite for the meets and bounds of the claim cannot be determined.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5, 14, 15, and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Lange, US patent 4,998,320. A caster, that may be used on a theatre prop (scenery in the since that it will be seen), comprises a first wheel 40; and a device to lock the wheel; wherein said device to lock

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the wheel is adapted to lock the wheel in position when said device is pressurized with a fluid. A swivel bearing wherein the swivel bearing is configured to allow the wheel to swivel about a swivel axis. The caster has a pneumatic cylinder 11. A spring loaded pin 28 and a brake disk 32 are provided. Wherein said pneumatic cylinder, said spring loaded pin and said brake disk are configured such that said brake disk is pressed onto said wheel thereby locking said wheel when said pneumatic cylinder is pressurized by said fluid. A mounting block wherein said mounting block is adapted to house said pneumatic cylinder.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lange. Lange discloses the claimed invention except for the particular range of values claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the

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device in this way, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. Such a modification is not critical to the design and would have produced no unexpected results.

Claims 9-11, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lange. Lange discloses the claimed invention except for two or three wheels. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modified the device in the this way, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ. Such a modification is not critical to the design and would have produced no unexpected results.

Allowable Subject Matter

9. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Williams whose telephone number is (703) 305-3438. The examiner can normally be reached on Monday through Friday.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark Williams
8/29/04



Suzanne Dino Barrett
Primary Examiner